## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

### Opinions of the Courts Below.

The opinion of the District Court is reported in 48 U. S. P. Q. 698, and is reproduced in the Record at pages 236 to 242, inclusive.

The opinion of the Circuit Court of Appeals for the Fifth Circuit is reported in 49 U. S. P. Q. 520, and will be found in the Record at pages 396 to 402.

### Jurisdiction.

The grounds for jurisdiction are:

1. The date of the judgment to be reviewed is May 16, 1941, rehearing denied June 16, 1941.
2. The judgment was rendered in a civil action brought under the patent statutes to determine the issues of validity and infringement of Letters Patent of invention.
3. The statute under which jurisdiction is invoked is 240(a) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.
4. Cases believed to sustain the jurisdiction are:

   *Leitch Manufacturing Company* v. *Barber Company,* 302 U. S. 458;

   *Carbice Corp.* v. *American Patents Development Corp.,* 283 U. S. 27;

   *DeForest Radio Co.* v. *General Electric Co.,* 283 U. S. 664.

## Statement.

The facts are sufficiently stated in the petition.

## Specification of Errors.

The errors which petitioners will urge, if the petition for certiorari is granted, are that the Circuit Court of Appeals for the Fifth Circuit erred

1. in sustaining Sutherland Patent No. 1,539,701 as valid;

2. in reversing the District Court's judgment that Sutherland Patent No. 1,539,701 is invalid;

3. in setting aside a dispositive finding of fact of the District Court, and predicating such action on the doctrine of comity rather than on the record before it;

4. in failing to affirm the judgment of the District Court that the alleged invention of Sutherland Patent No. 1,539,701 passed into the public realm on May 31, 1938, upon the expiration of the prior reissue Patent No. 16,116, granted to the same patentee for the same invention.

## Summary of Argument.

The points of argument follow the reasons relied upon for the grant of a writ of certiorari, and are stated on pages 6 and 7 of the petition as well as in the index hereto. For the sake of brevity they are omitted at this point.

## POINT I.

**The subject matter of the litigation is of great public importance, as is also the question of whether or not the monopoly of a patent which has passed into the public realm by expiration thereof, can be continued to be enforced by means of a subsequent, unexpired patent, issued to the same patentee for the same invention.**

The subject matter of this case consists of a necessary and universally used treatment of flour for making bread—a necessity of life. It is believed to be unnecessary to say more to show the public importance of the subject matter. A patent right sought to be enforced as a dominating factor relative to one of life's necessities, and which thereby reaches and affects every man, woman and child in the United States, warrants scrutiny by this Court as to its validity.

Of no lesser public importance is the question here presented which goes to the very heart and foundation of our patent system. The elementary consideration upon which a patent grant vests in its owner the right of exclusion for a period of seventeen years is the condition that the public shall be free to use the invention of the patent at the end of that seventeen year period. Here, by the opinion of the Court of Appeals below, a *subsequent* patent for the *same* invention, issued to the *same patentee,* has extended the monopoly for more than four years after the expiration of the first patent granted therefor, thus nullifying the presumed beneficial effect to the public of the patent statute, and depriving the public of the right to practice and utilize the invention of the patent upon its expiration.

There can be no serious dispute as to the facts bearing on this question. The District Court, after an exhaustive trial, found as a *fact* that the expired Sutherland patent and the unexpired Sutherland patent in suit were for the *same* invention, *and that on May 31, 1938 this common invention passed into the public realm* upon expiration of the first patent. *The Court of Appeals did not disturb that finding of fact.* As a principle of law it should not have done so; as a matter of proof, on the record before it, it could not have done so. Although it is believed that such finding of fact of the Trial Court is sufficient for the purposes of this petition, merely by way of illustration of the evidence upon which the District Court based its finding we here reproduce, in parallel columns, illustrative claims from both of the patents.

| *Claim 32 of the Expired Reissue Patent* | *Claim 10 of the Patent in Suit* |
|---|---|
| 1. As a new material of manufacture, an edible milling product carrying admixed therewith | An intimate mixture comprising a pulverulent cereal milling product in its normal substantially dry condition incorporated with |
| 2. a portion of a 'true peroxid' corresponding to not substantially more thereof than is necessary to bleach said product and to improve its baking qualities. | an exceedingly small percentage of a true peroxid as such, such peroxid having the property of bleaching the said milling product. |

From this comparison, it will be seen that there is complete identity of subject matter, language, elements, proportions, and purpose.

Apparently because of the indisputable character of the evidence before it, the Court of Appeals below neither criti-

cized, modified, nor reversed the fact finding of the Trial Court. Instead, the Court of Appeals substituted for this dispositive finding of fact the doctrine of *comity* based on a decision by the Court of Appeals for the Second Circuit, rendered nearly twelve years ago, under wholly different circumstances, and prior to the expiration of the first Sutherland patent, in a litigation in which the defendants in the present cause were not involved, and on a record which was not before it. It is submitted that a decision of such character and of such far reaching effect, striking down, as it does, the fundamental principle of the patent statute, and depriving the public of rights assured to it by the statute, is of such public importance as to warrant review by this Court.

## POINT II.

**The Court of Appeals below has decided an important Federal question in a way that is in direct conflict with the applicable decisions of this Court.**

Both as a matter of principle, as well as of law and precedent, the decision of the Court of Appeals below is manifestly erroneous. With the fact found by the Trial Court that the two Sutherland patents are for the same invention, which finding was not disturbed by the Court of Appeals below, the applicable law established by the prior decisions of this Court is clear and unequivocal. Thus, in *James* v. *Campbell*, 104 U. S. 356, this Court said:

> "It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself, any more than he could an invention embraced or described in a prior patent granted to a

third person. Indeed, not so well; because he *might* get a patent for an invention before patented to a third person in this country, if he could show that he was the first and original inventor, and if he should have an interference declared." *

Again, in *Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186, this Court said (p. 198):

> "The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more generical in its character, than the specific claims contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent essentially distinct and separable from the invention covered thereby, and claims made thereunder, its validity may be sustained.
>
> "In the last class of cases it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void."

These clear statements of the law have not been altered or modified throughout the years which followed their enun-

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* Emphasis ours in this brief.

ciation, and have been consistently followed by the lower courts.* No doctrine of lesser importance in law, or from the viewpoint of the public interest, should be allowed to be substituted therefor.

In consequence, it is manifest that the Court of Appeals below has rendered a decision which is in direct conflict with the decisions of this Court.

## POINT III.

**There is irreconcilable conflict of opinions of the Courts below wherein the Court of Appeals has substituted the doctrine of comity for a dispositive finding of fact by the Trial Court, which finding was not and could not have been found to be erroneous on the record before the Court of Appeals, and should have been regarded as "unassailable".**

As above pointed out, the Trial Court found that the two Sutherland patents were for the same invention, with the consequence, under the dictate of the decisions of this Court, that the second patent was wholly void. This finding of fact by the Trial Court was "unassailable" in the Court of Appeals unless it was manifestly erroneous (*Adamson* v. *Gilliland*, 242 U. S. 350; see also U. S. C. A. Title 28, Sec. 879; R. S. 1011; 18 Stat. 318). Obviously, that finding of fact was dispositive of the case. The Court of Appeals found no error in the finding. It was neither modified nor reversed—nor could it have been on the record before the

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* *Otis Elevator Co.* v. *Portland Co.*, 127 Fed. 557 C. C. A. (1st);
*Gold* v. *Gold*, 187 Fed. 273 C. C. A. (2nd);
*Lyon Fastener Inc.* v. *Hookless Fastener Co.*, 72 Fed. (2nd) 981 C. C. A. (3rd);
*Remington Rand Service* v. *Acme Card System Co.*, 71 Fed. (2nd) 628 C. C. A. (4th);
*Wire Bound Patents* v. *Saranac*, 65 Fed. (2nd) 904 C. C. A. (6th).

Court. The Court of Appeals merely substituted the doctrine of comity for the indisputable consequence and effect of the fact finding. This, it is submitted, constitutes manifest error warranting review and correction by this Court.

## POINT IV.

**Petitioners have been deprived of their constitutionally guaranteed right to an adjudication of the sufficiency and justice of their defense to a charge of patent infringement.**

By substituting the doctrine of comity for the fact finding of the Trial Court, and the adjudication based thereon, the Court of Appeals has deprived petitioners of their day in Court to which they have the guarantee of the Constitution. The defense they have raised to a challenge to their exercise of their natural rights as members of the public, has not been adjudicated on its merits. To the contrary, the merits of their cause have been disposed of by the Court of Appeals upon a decision of another Court, in a case in which they were not involved and in which they had no voice, and on a record which is not even before the Court of Appeals below to enable determination by anyone of what it comprised. The doctrine of comity was intended for no such thing, nor should it be allowed to accomplish any such result. Moreover, that doctrine should not be countenanced to perpetuate judicial error—an inevitable consequence of its application in the manner it has here been applied, as is illustrated by the facts of this case.

The District Court, though according respectful consideration to the prior decision of the Court of Appeals for the Second Circuit, found on the record before him that the established facts necessitated a different conclusion from

that reached by the Court of Appeals for the Second Circuit. He accorded the doctrine of comity every consideration to which it was entitled; he accorded defendants their day in Court and an adjudication on the merits of the defense they had raised; he *found as a fact* that the two Sutherland patents were for the same invention, and that the patent in suit was invalid because thereof.

The Court of Appeals, however, did none of these things. To the contrary, it ignored the record in the case; it ignored the fact findings of the Trial Court, and substituted the doctrine of comity therefor, thus forever binding petitioners by a decision rendered in a case to which they were not parties, on evidence of which the Court itself is not informed, thereby making it possible—and in this case an established fact—to perpetuate judicial error and avoid conflict of opinion and review by this Court, a procedure which the Federal Judicial System contemplated and provided for.

Particularly apt is the language of Judge Borquin in *Lektophone* v. *Rola* (27 Fed. (2d) 758), upon whom was urged the doctrine of comity founded on the prior decision of the Court of Appeals for the Third Circuit in *Lektophone Corp.* v. *Brandes Corp.*, 20 Fed. (2d) 155, which had held the patent there in suit to be valid and infringed. He stated (p. 761):

> "If otherwise alike, that case and this differ in judgment, which suffices to forbid conformity merely to comply with the rule of comity urged.
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> Too often is the rule invoked to extend the operation of erroneous decisions, and to defeat review by the Supreme Court, or for the sake of appearances, and face-saving. Justice is more than these latter—is the substance whereof they are the shadows sometime distorted. To change judgment out of mere comity is perversion of judicial function and defeat

> of justice. And yet it is done whenever the facts and findings in one patent case are taken into account in another, to the prejudice of a party in the latter who is a stranger to the former. See Carson, etc., Co. v. Anaconda Copper Mining Co. (D. C.) 17 F. (2d) 816; Id. (C. C. A.) 26 F. (2d) 651. For this judicial rule, peculiar to patent cases tried in equity, is no justification in principle."

It is of interest to note that the decision of Judge BORQUIN in that case, which refused to follow the prior decision of the Third Circuit Court of Appeals under the doctrine of comity, was affirmed both by the Ninth Circuit Court of Appeals (34 Fed. (2d) 264) and by this Court (282 U. S. 168).

It is believed, therefore, that the error of the Court of Appeals below is manifest, and its judgment should be reviewed and corrected by this Court.

## *Conclusion.*

***Wherefore petitioners earnestly pray that the petition for writ of certiorari be granted, the case be reviewed, and the decree of the Court of Appeals for the Fifth Circuit finding validity for Sutherland Patent No. 1,539,701 be reversed.***

Respectfully submitted,

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